

**UNITED STATES COURT OF APPEALS FOR THE FEDERAL
CIRCUIT**

2007-1221
(Interference No. 105,455)

IN RE HAROLD R. GARNER,

Appellant.

On Appeal from the Board of Patent Appeals and Interferences,
Patent Interference No. 105,455

REPLY BRIEF OF APPELLANT HAROLD R. GARNER

July 28, 2007

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FORM 9. Certificate of Interest

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Gamer

v. Quate

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No. 2007-1221

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appellant certifies the following (use "None" if applicable; use extra sheets if necessary):

1. The full name of every party or amicus represented by me is:

Harold R. Garner

2. The name of the real party in interest (if the party named in the caption is not the real party in interest) represented by me is:

NimbleGen Systems Inc.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. ☒ There is no such corporation as listed in paragraph 3.

5. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Quarles & Brady LLP

Bennett J. Berson, Nicholas J. Seay, Anthony A. Tomaselli, and Kristin G. Noel

4/2/07

Date

Anthony A. Tomaselli
Signature of counsel

Anthony A. Tomaselli
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Reset Fields

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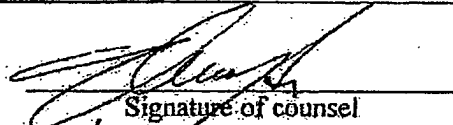
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Date


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INTRODUCTION

The issues before the Court directly impact the standard to which the threshold showing of priority should be held. In the case at hand, Garner's initial showing was sufficient to pre-date his filing by the *six days* necessary to provoke an interference. Yet, the Board failed to consider information within its own file, including the *very application at issue* when ruling on the sufficiency of Garner's initial showing. Instead of accepting the truth of Garner's evidence as it must under the low *prima facie* standard, it attempted to rebut it. This was error.

The Board then compounded its initial error by giving new meaning to the plain language of Rule 202(d) and interpreting "new evidence" to include documents that were anything but new. In fact, the Board classified the application at issue -- the very basis for the interference -- as "new." As a result of this interpretation, the Board once again blinded itself to the information within its grasp and denied Garner the ability to contest the priority of an application he filed a mere six days after the senior party. In a first to invent system such as ours, a *six* day difference in filing dates should not bar a challenge to priority when the junior party has presented evidence that it reduced the claimed invention to practice more than *six months* before its filing date. The Board's decision on the sufficiency of Garner's showing, as well as its definition of "new evidence" is an abuse of its discretion.

In Response, the Solicitor applies a heightened standard of scrutiny and relies on inapposite cases and a Standing Order that was not even in place before the initial showing. Finally, and most importantly, the Solicitor ignores the fact that the claimed “new evidence” was *already* in the record.

As with the Board, the Solicitor ignores the purpose of the Interference, electing to advocate rigid interpretations of formulaic rules over substance and common sense. The Board’s decision should be reversed.

ARGUMENT

I. GARNER’S INITIAL SHOWING WAS SUFFICIENT.

The Solicitor’s arguments regarding reduction to practice and corroboration confuse the fact that the issue at this stage is not whether Garner can establish priority, but whether Garner has the right to contest priority. Garner is at a threshold stage in the proceeding. Thus, the issue is whether Garner has made a *prima facie* case that he was in possession of the subject matter of the count at least six days prior to his filing date. Garner’s initial showing did this.

Evidence establishing a “*prima facie* case need not be overwhelming or even destined to prevail.” Bellaver v. Quanex Corp./Nichols-Homeshield, 200 F.3d 485, 493 (7th Cir. 2000). Instead, the party “need only present some evidence” from which one can infer success. Id. In the context of an interference, “it is assumed that the allegations in appellants’ affidavits are true.” Kahl v. Scoville,

609 F.2d 991, 995 (C.C.P.A. 1979). In addition all reasonable inferences must be made in favor of the party attempting to show the *prima facie* case. Rule 202(d); *see also* Fed. R. Civ. P. 56(c). Therefore, arguments that attempt to rebut the showing are "premature and cannot be considered until after the interference has been declared." Kahl, 609 F.2d at 996.

Yet, the Board's decision and the Solicitor's brief do just that in that they refuse to consider Garner's affidavits as true, refuse to make reasonable inferences in Garner's favor and instead attempt to rebut the evidence presented. Contrary to the Solicitor's assertions, Garner submitted sufficient evidence demonstrating that the device Garner constructed: (1) contained all of the components required by the count; (2) worked for its intended purpose; and (3) was corroborated by independent evidence.

A. The Initial Showing Contained All of the Components Required by the Count.

Both the Board and the Solicitor overlook information properly before the Board that was incorporated by reference in Garner's initial showing. The initial showing incorporated by reference documents containing all of the components of the count and, therefore, contained all of the components required by the count. Incorporation by reference "provides a method for integrating material from various documents into a host document by citing such material in a manner that makes clear that the material is effectively part of the host document as if it were

explicitly contained therein.” Cook Biotech, Inc. v. Acell, Inc., 460 F.3d 1365, 1374 (Fed. Cir. 2006). The standard for whether a document has been incorporated is whether one reasonably skilled in the art would understand the document to be incorporated with sufficient particularity. Advanced Display Sys. v. Kent State Univ., 212 F.3d 1272, 1283 (Fed. Cir. 2000). In an interference, affidavits may incorporate by reference other affidavits or relevant documents. Kahl, 609 F.2d at 995 (“it is, of course, permissible for one affidavit to incorporate by reference a discussion contained in a contemporaneous affidavit”).

Garner incorporated both the ‘948 provisional application and the application at issue by stating that the purpose of the declaration was “to establish completion of the invention, which is the subject of the Continuation of Patent Application Serial No. 09/326,526, filed June 4, 1999, entitled ‘DIGITAL OPTICAL CHEMISTRY MICROMIRROR IMAGER,’ which claims priority to Provisional Patent Application Serial No. 60/087,948.” (JA166). The application at issue, the ‘341 application, is the continuation of the ‘526 application. Therefore, Garner’s statement included both pending application and the provisional.

The Garner 2005 declaration explains that attached pictures, taken in 1997, show that “the device *as claimed* had been built and was operating” and that “the device *as claimed* had been not only conceived but reduced to practice.” (JA166)

(emphasis added). These repeated references to “the device as claimed” further evidence that the device pictured in the attached photographs was understood by Garner to correspond to the claims of the referenced applications.

Because both of the referenced applications contain the elements of the count (namely, a light source, a computer controlled micromirror, and a reaction chamber) by incorporating these applications Garner’s declaration also includes all the elements. Specifically, the provisional application states “[a] computer is connected to, and controls, the micromirror and a substrate holder, such as a reaction chamber, that is placed in the path of light redirected by the micromirror, wherein light that is redirected by the micromirror catalyzes a chemical reaction proximate the substrate.” (JA 0049). The provisional application discusses these three elements in greater detail explaining how they interact with each other and resulting substrate patterns they produce. (JA 0049-0081).

As support for Garner’s statement that his device was consistent with the claims of the application at issue, a photograph of the device was attached to the declaration containing labels describing each of the claimed elements. The labels are consistent with the language used to describe the very same elements in the referenced applications. For example, the term “DLP” was defined in the provisional application as a “Digital Light Processor” micromirror array manufactured by Texas Instruments and the term “DOC” refers to the title of the

provisional application, Digital Optical Chemistry Micromirror Imager and is used throughout the application interchangeably with the term “micromirror imager” (JA 0054 - 0055). Thus, to understand that the labels attached to the pictured device included all the elements of the count, the Board merely needed to view the picture alongside the referenced applications. As such, the Board’s position that it did not have adequate information to understand the labels is a result of the Board’s unreasonable refusal to consider the referenced applications, not Garner’s failure to provide the references.

B. The Initial Showing Contained Evidence that the Device Worked for its Intended Purpose.

Garner’s 2005 declaration states that the photograph taken in 1997 “demonstrates that the device as claimed had been built and was operating.” (JA 166 ¶ 4). The declaration further states that the device “had been not only conceived but reduced to practice.” (JA 166 ¶ 4). The attached pictures depict the device, lending credibility to Garner’s statement that it was built and operating. (JA 168-169). Additionally, laboratory notebook pages confirm that the device successfully worked for an intended purpose. Specifically, the notebook pages list reactions under the title “Chemistry of *successful run*” and show a photograph labeled “mask.” (JA 171-172)(emphasis added). Significantly, the material is dated November 11, 1997, well before the May 1998 date Garner must pre-date.

When viewed in light of the relevant applications, the materials taken as a whole satisfy the low burden of a *prima facie* standard.

Yet, instead of accepting these statements as true, the Board attempts to rebut the inventor's conclusions and deemed the statements insufficient because they lack a detailed explanation of how the device worked. (JA 23). Such rebuttal is premature and should be addressed after the parties have moved beyond this threshold stage. Kahl, 609 F.2d at 996.

C. The Initial Showing was Corroborated.

When evaluating whether the inventor's testimony has been sufficiently corroborated, "all of the evidence of record must be collectively evaluated." Price v. Symsek, 988 F.2d 1187, 1195 (Fed. Cir. 1993). The standard for corroboration "is not inflexible and is not to be applied mechanically." Mikus v. Wachtel, 542 F.2d 1157, 1159 (C.C.P.A. 1976). Documentary evidence combined with the activities of others may be corroborative and often testimony that an independent observer had "some first-hand knowledge" is significant. Id. Thus, to establish a *prima facie* showing of corroboration, "it is sufficient if the picture painted by all of the evidence taken collectively" makes it more likely than not that the inventor's statements can be corroborated should the interference move forward. Price, 988 F.2d at 1196; Kahl, 609 F.2d at 994-996.

Garner's statements were corroborated in multiple ways. First, and most significantly, Garner submitted the declaration of an independent observer who saw the completed prototype in Garner's lab in November of 1997 and confirmed that the submitted photograph was an accurate depiction of the invention. (JA 138-139). This photograph, having been authenticated by both Garner and an independent observer, is also a form of independent corroboration.

Garner also attached copies of laboratory notebook pages dated November 11, 1997. (JA170-175, some pages more clearly photocopied JA 125-127). The notebook pages written in two different handwritings, and evidence a partial signature of someone other than Harold Garner. (JA 119). The pages contain a variety of notes as well as a picture of the pattern that was created. Ironically, the Board criticized the picture as showing a "vague speckled rectangle," yet, the rectangle is exactly what the picture was intended to show, as illustrated when compared to clearer patterns included in the provisional application. (JA 23; JA 81). While repeated photocopying had diminished the picture quality, the fact that a rectangle is visible is independent evidence that the invention was used to produce a rectangle pattern. Additionally, one of the notebook pages is titled: "Chemistry of Successful run" and contains a series of chemical reactions. (JA 172; JA 183). Taken as true for the purposes of the *prima facie* showing, these notebook evidence a contemporaneous expression of success

occurring on November 11, 1997, months prior to the May 1998 date Garner is attempting to pre-date. (JA 183).

These multiple elements, taken as a whole, assumed true and entitled to all reasonable supporting inferences are *prima facie* evidence that Garner reduced the invention to practice more than six days before he filed his provisional application. As such, he should be given the opportunity to contest priority and call as witnesses those who authored the notebook pages in question.

II. THE BOARD ABUSED ITS DISCRETION.

The Board abused its discretion when it classified previously submitted evidence as “new evidence.” In addressing this issue, the Solicitor has relied upon inapposite case law, out of date rules, and inaccurate factual assertions.

A. The Cases Cited by the Solicitor are Inapplicable.

In the Response, the Solicitor argues that Garner is not entitled to relief here because he did not show “good cause” to add new evidence, principally relying upon two legal authorities: Hahn v. Wong, 892 F.2d 1028 (Fed. Cir. 1989) and Huston v. Lander, 973 F.2d 1564 (Fed. Cir. 1992). The Solicitor’s arguments regarding good cause are irrelevant to the issue at hand. Garner did not attempt to, nor was he required to, show good cause because Garner did not submit new evidence.

Moreover, both Hahn and Huston are inapplicable here because they were decided under rules no longer in effect. As Garner presented in his opening brief (Garner Br. pg. 32), Rule 608 never used the term “new evidence.” Rather, as Hahn and Huston highlight, Rule 608 specifically precluded a party from presenting “evidence was *not initially presented with the evidence filed under § 1.608(b)*” as part of the initial showing. 37 C.F.R. § 1.608(b) (2004)(emphasis added). Rule 608 is no longer in effect and the rule that replaced it does not include this limitation. 37 C.F.R. § 41.202. In fact, the language referencing evidence “not initially presented” has been deleted. Id. Had “new evidence” been intended to have the same definition as the previous rule, the language would not have been changed. The proper starting point for interpretation “is the existing statutory text, and not the predecessor.” Lamie v. United States Tr., 540 U.S. 526, 534, 124 S. Ct. 1023, 1030 (2004). Thus, the Solicitor’s reliance upon case law than applies outdated statutes is misplaced.

In support for the position that the Board’s interpretation is consistent with the regulatory history, the Solicitor relies on Kistler v. Weber, 412 F.2d 280 (C.C.P.A. 1969). Yet, just like Hahn and Huston, Kistler is not on point. In Kistler, the application at issue was filed several months before that of the senior party. The issue there was whether the affidavits were sufficient corroboration, not whether previously submitted material, such as the application could be

considered. Kistler, 412 F.2d at 287-288. As such, the meaning of “new evidence” was never discussed.

Furthermore, the Solicitor’s suggestion that Garner’s corroborative evidence is comparable to Kistler is unpersuasive. Kistler presented an unsigned notebook and affidavits of individuals who were aware of his work, but never witnessed the end product. Id. at 288. As the Court noted, none of this evidence indicated that “he subjected the product of his process to tests.” Id. at 288. In contrast, Garner has submitted the affidavit of a witness who saw the completed device, photographs of the completed device, laboratory notebooks signed by individuals other than Garner, the chemical reactions that resulted in a successful use, and photographs of the rectangular pattern that the device produced during a successful use. As a result, Kistler, like Hahn and Huston, is an inappropriate comparison.

B. The Factual Assertions Regarding Garner’s Documents are Inaccurate.

Even if the Rule 608 cited in Hahn, Huston and Kistler was currently in effect, those cases are factually distinct from the facts at hand as none of those precedents address the issue of whether the Board should consider documents that were incorporated by reference in the initial showing. The Solicitor’s statements that Garner’s documents were submitted for the first time in response to the show cause order (PTO Br. pg. 19.), are inaccurate. Documents at issue were within the record before the Board. Specifically, both the ‘948 provisional application and

the application at issue, also known as the continuation of patent application '526 or the '341 application, were directly referenced in the first paragraph of the Garner's 202(d) declaration. (JA 166 ¶ 1). Garner identified their serial number, their filing dates, and their title. (JA 166). Additionally, Garner cited the '341 application as the application at issue at the top of the page and made references to "the invention of this application" and the "device as claimed" throughout paragraphs 4 and 5. (JA 166 -167 ¶¶ 4, 5). As such, these applications, including the specifications the applications contain, were incorporated by reference in the initial showing, a critical difference from the documents considered in the cases cited by the Solicitor, which at one point addressed an affidavit from counsel for the applicant created well after the initial showing at issue. Huston, 973 F.2d at 1565.

Because Garner identified the provisional application, as well as the application at issue, and made multiple references to the device these applications claimed, the Board should have interpreted the declaration referencing these documents in light of the claims referenced. The Board erred by refusing to consider these documents when reviewing the initial showing and it was an abuse of discretion for the Board to ignore these documents when they were again brought to the Board's attention in response to the Board's order to show case.

Moreover, even if Garner had not incorporated the specification of the application at issue, the Board should have considered it. "It is fundamental that patent claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 86 S. Ct. 708 (1966). Thus, "our cases recognize that the specification may review a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." Cook Biotech, Inc., 460 F.3d at 1373, citing Philips v. AWH Corp., 415 F.3d 1303, 1316 (Fed. Cir. 2005). It follows that when interpreting language related to the claimed invention, the Board should have considered the specification of the application at issue, rather than claiming that it had no way to determine the meaning of the language used throughout the applications, pictures and declarations.

The Board's refusal to consider the specification of the application at issue is even more illogical when one realizes that the specification was already before the Board. Whether or not the applicant submits the specification of the application at issue, the Board is instructed to review the specification to determine the meaning of the copied claim. Rule of Practice Before the Board of Patent Appeals and Interferences, 68 F.R. 66648, 2003 WL 22794143 (Nov. 26, 2003). In fact, when determining patentability in an interference proceeding the Board is required to

look to the specification of the host disclosure even in situations when a party is urging the Board to look to the specification of the originating disclosure. Rowe v. Dror, 112 F.3d 473, 479 (Fed. Cir. 1997) (reversing a Board decision and holding that the PTO must interpret the claim in light of the specification in which it appears).

The Solicitor argues that claim interpretation and priority are “unrelated.” (PTO Br. pg. 29). While the two showings are different subparts of the same statute (sub(a) vs. sub(d)), this distinction trivializes the point that both showings are part of the same initial showing required to suggest an interference and are often submitted as part of the very same document. 37 C.F.R. § 41.202. Compartmentalizing knowledge to this extent serves no useful purpose. The Board does not save any time or effort by referring to the specification for subpart (a), but then refusing consider the same information when considering subpart (d).

“Legal technicalities should be pursued only in the interest of orderly procedure and applied only where they serve that end.” Golden Gate Salami Co. v. Gulf States Paper Corp., 332 F.2d 184, 191 (C.C.P.A. 1964). Yet, the Board has focused on legal technicalities, and factual examples that are not relevant to the case at hand. Instead of addressing the fact that none of documents submitted were newly created affidavits, and therefore not “new evidence,” the Board chose to focus on the good cause requirement without explaining why a good cause

showing would be required to discuss the applications that were referenced in Garner's initial showing. Even the quoted Standing Order focuses on affidavits and therefore is unrelated to the applications that are central to this appeal.

C. The Standing Order Does Not Govern Initial Showings.

Finally, the Solicitor's reliance on the Standing Order is misplaced. The Standing Order governs "contested cases assigned to the Trial Division of the Board of Patent Appeals and Interferences." (JA 0196). Garner's initial showing was not filed in a contested case assigned to the Board, and thus the Standing Order did not govern Garner's initial showing. 37 C.F.R. §§ 41.2 (defining "contested case"), 41.100 (defining "involved"), 41.102 (generally establishing that examination must be completed before a contested case is initiated), 41.103 (defining that the Board acquires jurisdiction over involved files when the Board initiates a contested case). Indeed, according to the PTO's own docket sheet, the Standing Order was issued in the interference on September 6, 2006. (JA 0029). Garner filed his Rule 202(d) showing on January 26, 2006. (JA007). Thus, the Standing Order is inapplicable to the initial showing and cannot retro-actively mandate that Garner was obligated in his initial showing to have physically re-filed copies of record documents already before the PTO.

CONCLUSION

The issue before the Court is the threshold question of the right to contest to priority. A mere *six days* separate the filing dates of the two parties. As the junior party, Garner was required to make a *prima facie* showing that he could pre-date his June 4, 1998, filing date by six days. As evidence, Garner submitted declarations, pictures, and laboratory notes dating back to fall of 1997, months beyond the six days required. Faced with this evidence, the Board made two errors. First, it erred when it concluded that this showing was insufficient to meet the low *prima facie* standard. All of Garner's submissions are assumed true and he is entitled to every reasonable inference supporting his position. Second, the Board erred when it classified previously submitted documents as "new evidence" and refused to consider all of the relevant material at hand. This case presents an opportunity to choose substance before rigid formulaic rules by reversing the Board's decision and allowing the 202(d) submission to be the threshold showing it was intended to be.

Dated this 28th day of July, 2007.



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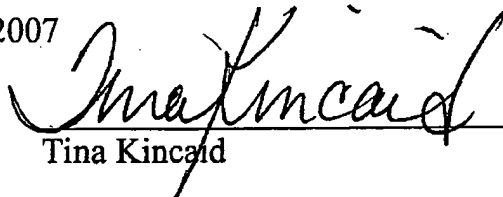
CERTIFICATE OF SERVICE

I, Tina Kincaid, am over the age 18 years of age and am not a party to the above action. I am an employee of Quarles & Brady LLP, 33 East Main Street, Suite 900, Madison, Wisconsin 53703. On the below date, in the ordinary course of business, I served two copies of the Reply Brief of Appellant Harold R. Garner via Overnight Delivery to the below listed attorneys of record in this action.

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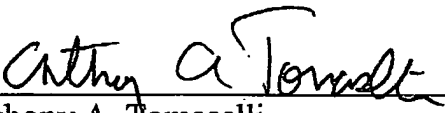
Dated this 28th day of July, 2007


Tina Kincaid

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
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AND TYPE STYLE REQUIREMENTS**

1. This brief complies with the type-volume limitation of Federal rule of Appellate Procedure 32(a)(7)(B). The brief contains 3,650 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)B(iii) and Federal Circuit Court Rule 32(b).
2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2003 in 14 Times Roman font.

Dated this 28th day of June, 2007



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